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Ivar M Kaardal  
Kaardal & Associates PC  
3500 South First Avenue Circle Suite 250  
Sioux Falls, SD 57105-5802

EXAMINER

CHIANG, JACK

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/593546

Applicant(s)

D. Robinson

Examiner

J. Chiang

Group Art Unit

2642

#8

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 4-21-03.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 7, 15-24 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 7, 15-24 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

**CLAIMS**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7, 15-18, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Provence (US 5501329) in view of Sherman (US 3856571).

Regarding claims 7, 15-18, Provence shows:

An earpiece cover attachment (10) comprising:

A central wall (12) having front and back surfaces and an outer perimeter;

A perimeter wall (16);

A space (for the handset);

Holes (26);

A mouthpiece cover attachment (10) comprising:

A primary wall (12) having front and back surfaces and an outer perimeter;

A peripheral wall (16);

A space (for the handset); and

Holes (26).

Provence further shows a case having a pivotal lid (see 40).

Provence differs from the claimed invention in that it does not show the design of the claimed case, such as a central section, the pair of lobes, the locking mechanism or tab.

However, Sherman teaches providing a case (14) having a central section (location of 88), a pair of lobes (80), and the locking tab (88).

Hence, both Provence and Sherman are carrying cases which are commonly carried by users. Although the products that are being carried are different, but these products are carried and used together everyday by consumers. Therefore, it would have been obvious for one skilled in the art to apply the design of Sherman's carrying case to carry sanitation covers, such as Provence's covers or other design of sanitation covers. This can be considered as an intended use of the design of Sherman's case in the environment shown by Provence, because the function and design of Sherman's case is substantially the same, the change in the product that is being carried would not change the overall function and design of the case.

Regarding claims 20-22, the combination of Provence shows:

A ridge which forms a substantially closed chamber (see locations of 20, 22, 24 in fig. 5);

A lip for directing voice sounds (see location of 20 in fig. 5, and its application with the mouthpiece in fig. 1); and

A plurality of sound holes (see 26, or holes in fig. 1).

3. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Provence and Sherman in view of Lo et al. (US 5054063).

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Regarding claim 19, the combination of Provenge shows the primary wall of the mouthpiece (12, 10).

The combination of Provenge differs from the claimed invention in that it does not show a marking.

However, Lo, in a phone cover, teaches providing a marking (ADVERTISEMENT) on the primary wall of a mouthpiece (col. 3, lines 28-35).

Hence, it is commonly seen that products are printed with the information of the manufacture, including address, phone numbers and instruction etc.. Therefore, it would have been obvious for one skilled in the art to modify the combination of Provenge with a marking as taught by Lo, such that to market the product and the manufacture, this is commonly done by manufacture and therefore would have been obvious for one skilled in the art.

4. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Provenge and Sherman in view of Finlayson et al. (US 2595517).

Regarding claims 23-24, the combination of Provenge shows the mouthpiece having a lip for directing voice sounds (see comments above).

The combination of Provenge differs from the claimed invention in that the lip is circular instead of semicircular.

However, from various embodiments shown by applicant, such as figs. 2, 4, 6 etc., the lip can be circular or semicircular. In other words, there is no teaching of criticality for circular over semicircular, or vice versa. The concept here is to direct voice sounds to

the microphone holes. Circular or semicircular lip would achieve the same objective.

Further, Finlayson teaches providing a semicircular lip (figs. 1, 3).

Hence, it would have been obvious for one skilled in the art to use Provence's mouthpiece having the circular lip as it is, or modify Provence's mouthpiece with a semicircular lip with/without the teaching of Finlayson. This simply can be considered as a variation of the combination of Provence, because changing the circular lip to semicircular lip, or vice versa, would not change the function of the mouthpiece in the combination of Provence.

5. Claims 7, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wachs et al. (US 3169171) in view of Sherman (US 3856571).

Regarding claims 7, 15-18, Wachs shows:

An earpiece cover attachment (20) comprising:

- A central wall (22) having front and back surfaces and an outer perimeter;

- A perimeter wall (24);

- A space (for the handset);

- Holes (see 22);

A mouthpiece cover attachment (20) comprising:

- A primary wall (22) having front and back surfaces and an outer perimeter;

- A peripheral wall (24);

- A space (for the handset); and

- Holes (see 22).

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Wachs further shows a case having a lid (see fig. 6).

Wachs differs from the claimed invention in that it does not show the design of the claimed case having a pivotal lid, such as a central section, the pair of lobes, the locking mechanism or tab.

However, Sherman teaches providing a case having a pivotal lid (see 14) comprising a central section (location of 88), a pair of lobes (80), and the locking tab (88).

Hence, both Wachs and Sherman are carrying cases which are commonly carried by users. Although the products that are being carried are different, but these products are carried and used together everyday by consumers. Therefore, it would have been obvious for one skilled in the art to apply the design of Sherman's carrying case to carry sanitation covers, such as Wachs's covers or other design of sanitation covers. This can be considered as an intended use of the design of Sherman's case in the environment shown by Wachs, because the function and design of Sherman's case is substantially the same, the change in the product that is being carried would not change the overall function and design of the case.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Wachs and Sherman in view of Lo et al. (US 5054063).

Regarding claim 19, the combination of Wachs shows the primary wall of the mouthpiece (12, 10).

The combination of Wachs differs from the claimed invention in that it does not show a marking.

However, Lo, in a phone cover, teaches providing a marking (ADVERTISEMENT) on the primary wall of a mouthpiece (col. 3, lines 28-35).

Hence, it is commonly seen that products are printed with the information of the manufacture, including address, phone numbers and instruction etc.. Therefore, it would have been obvious for one skilled in the art to modify the combination of Wachs with a marking as taught by Lo, such that to market the product and the manufacture, this is commonly done by manufacture and therefore would have been obvious for one skilled in the art.

7. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Wachs and Sherman in view of Zimmermann (US 2593382).

Regarding claims 20-22, the combination of Wachs shows the earpiece and mouthpiece (see comments above).

The combination of Wachs differs from the claimed invention in the it does not explicitly show a ridge and a lip.



However, Zimmermann teaches providing a ridge and a lip for the earpiece and mouthpiece respectively.

Hence, it would have been obvious for one skilled in the art to modify the combination of Wachs with a ridge and a lip for the earpiece and mouthpiece respectively as taught by Zimmermann, such that to direct sounds with respect to the speaker and microphone of the handset. This is a well known feature in handset design shown by various arts cited in the present application.

8. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Wachs, Sherman and Zimmermann in view of Finlayson et al. (US 2595517).

Regarding claims 23-24, the combination of Wachs shows the mouthpiece having a lip for directing voice sounds (see comments above).

The combination of Wachs differs from the claimed invention in that the lip is circular instead of semicircular.

However, from various embodiments shown by applicant, such as figs. 2, 4, 6 etc., the lip can be circular or semicircular. In other words, there is no teaching of criticality for circular over semicircular, or vice versa. The concept here is to direct voice sounds to the microphone holes. Circular or semicircular lip would achieve the same objective.

Further, Finlayson teaches providing a semicircular lip (figs. 1, 3).

Hence, it would have been obvious for one skilled in the art to use Wachs's mouthpiece having the circular lip as it is, or modify Wachs's mouthpiece with a semicircular lip

with/without the teaching of Finlayson. This simply can be considered as a variation of the combination of Wachs, because changing the circular lip to semicircular lip, or vice versa, would not change the function of the mouthpiece in the combination of Wachs.

### **ARGUMENT**

9. In response to the remarks (pages 5-9), applicant mainly argues that Provence ... covers means 12 should be coupled together when not use ..., ... Sherman... has separated storage chamber .... suitable for holding items that cannot be stored in close proximity to each other. Applicant further cited law cases to support his argument.

The examiner will provide the following comments in response to the above argument. First, it is true that the best way to store Provence's covers is to couple the covers together. This idea is also shown by applicant's fig. 4 and page 10 last six lines of the present specification. However, this is not the only way to store such covers. This is also shown by Wachs, including Figs. 4-5 of the present application. For example, in fig. 4 of the present application, the covers are coupled together, and in fig. 5 of the present application, the covers are separated and stored in a case. It is not seen there is any criticality for fig. 4 over fig. 5, or vice versa. It is a matter of a user's choice. Second, in the combination of Provence and Sherman, if a user wants to store covers, such as Provence's covers or Wachs' covers or even applicant's covers, in a carrying case like Sherman's, it is not seen there is any problem.

In conclusion, sanitation covers come in different forms and shapes, the criteria is to fit onto the handset. The carrying case is a different issue, it can come with different

design and personal preference as long as it can hold the covers. The above cited arts have addressed all the claimed limitations.

10. Applicant's arguments with respect to claims 7, 15-24 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

  
Jack Chiang  
Primary Examiner  
Art Unit 2642